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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/309,131

Applicant(s)

GEER, TERRY L.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1,4,8-11 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-7, 12-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The issues raised with regard to claim 13 in the previous rejection of record based on 35 U.S.C. 112 have not been overcome and are herein repeated.

In claim 13, line 1, the phrase “cash letters” appears to actually refer to the “cash letters” of claim 12, and as such should be preceded with the term “the” or “said” to show that antecedent basis has been established.

Claims 2, 3, 5-7, 12-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 18 and 19 are indefinite because they do not identify any means for transferring the image from the capture facility where it is created to the periodic statement. The claims have a “the capture facility further including means for processing a financial instrument in accordance with a truncation procedure in which a visually perceptible record corresponding to the data record of the financial instrument is created” and then they state, “the visually perceptible record of the financial instrument is transmitted . . . and . . . is displayed in a periodic statement delivered on behalf of the custodian to the payor” however it is unclear how the

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visually perceptible record gets from the creation point to being incorporated into a periodic statement.

Claims 2, 3, 5-7, 12-17 and 20-30 are indefinite because they depend from rejected base claims 18 and 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5-7 and 12-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens et al. (US 5,237,159) in view of Behera (US 5,187,750).

The Stephens patent discloses a system for effecting the deposit and submission of paper and financial instruments comprising:

An item capture facility for receiving the instruments (partner banks, col. 4, lines 57-68) (claims 18 and 19);

A billing statement (cash letters, col. 5, lines 11-51) (claim 24);

A means at the capture facility for deriving funds transfer information and converting the information into a data record (CPCS, col. 4, lines 57-68 and col. 5, lines 1-10) (claims 18 and 19);

A means for associating information in the data record with a record associated with the payor maintained in the payee's record of accounts (CIF system, col. 5, lines 65-68 and col. 6, lines 1-68) (claims 18 and 19);

An archive (centralized storage, col. 6, lines 3-68) (claims 6, 7, 18, 19 and 27);

A communication link (communication techniques, col. 5, lines 22-29) (claims 18 and 19);

A means for applying an indorsement indicia on behalf of the payee and the depository bank of the payee (headers, col. 8, lines 1-68) (claim 19);

A processing means (CPCS, col. 5, lines 1-10) (claims 18 and 19);

A sorter for identifying record according to categories and for assembling bundles of records corresponding to the categories (system that bundles checks, col. 5, lines 11-21) (claims 18 and 19); and

A controller that coordinates the transmission of cash letter information (CPCS, col. 5, lines 11-21) (claims 18 and 19);

The capture facility further including means for processing a financial instrument in accordance with a truncation procedure in which a visually perceptible record of the financial instrument is created corresponding to the data record for said financial instrument (MICR line data, col. 4, lines 57-68 and col. 5, lines 1-11) (claims 18 and 19);

The data record includes information corresponding to the MICR line (col. 4, lines 57-67) (claims 2 and 5);

The capture facility includes means for receiving one or more than one check (col. 4, lines 57-67) (claims 3 and 30);

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More than one cash letter is delivered into the payment system (col. 5, lines 11-21) (claims 12, 20 and 28);

Cash letters include electronic cash letters and paper cash letters (col. 5, lines 11-29) (claims 13, 21 and 29); and

The payment system to which cash letters are delivered is one of the Federal Reserve and a private clearing house (col. 3, line 62 through col. 4, line 5) (claims 22 and 23).

The Stephens patent lacks:

The visually perceptible record of the financial instrument is transmitted to the custodian of the payor's account, and an image derived from the visually perceptible record is displayed in a periodic statement delivered on behalf of the custodian to the payor (claims 18 and 19); the means for creating a visually perceptible record comprises an imager that creates an electronic image (claims 3 and 30); an image of the visually perceptible record associated with the payment is returned to the payor in paper format (claims 14 and 15) and electronic format (claims 16 and 17); and the financial instrument is disposed of after a visually perceptible record of the financial instrument is created (claims 25 and 26).

The Behera patent teaches:

The means for creating a visually perceptible record comprises an imager that creates an electronic image (8i, col. 4, lines 10-23) (claims 3 and 30);

An image of the visually perceptible record associated with the payment is returned to the payor in paper format (col. 8, lines 27-35 and col. 9, lines 38-41) (claims 14 and 15) and electronic format (col. 4, lines 43-62, since the system already provides for the images to be

transferred from one location to another, and it allows for the records to be returned to the payor in printed paper form it is obvious that the records could more readily and easily be transferred via electronic form to the payor and save the time, cost and energy associated with printing out the record) (claims 16 and 17); and

The financial instrument is disposed of after a visually perceptible record of the financial instrument is created (Examiner takes official notice that it is common knowledge that physical documents are disposed of once images have been made thereof so as to save storage space and provide for more easily accessible documents) (claims 25 and 26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Stephens patent with the teachings of the Behera patent so as to provide a more efficient, cost effective and less redundant system. Also so as to reduce the amount of energy and effort that was spent physically moving papers from one location to another.

Response to Arguments

Applicant's arguments filed 3-26-03 have been fully considered but they are not persuasive.

The objection to claim 18 has been successfully overcome.

The claims rejections based on 35 U.S.C. 112, second paragraph have been overcome with the exception of claim 13 which is restated above.

The rejection based on 35 U.S.C. 102 has been withdrawn in view of the newly amended claims.

Allowable Subject Matter

The previous indication of allowable subject matter has been withdrawn in view of the newly amended claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Uhland, Sr., Bednar et al., and Cahill et al. patents are all directed to various types of image capture systems.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SS

September 12, 2003


HANI M. KAZIMI
PRIMARY EXAMINER